

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BRIGHT HOUSE NETWORKS, LLC, WIDEOPENWEST  
FINANCE, LLC, KNOLOGY OF FLORIDA, INC., and  
BIRCH COMMUNICATIONS, INC.,  
Petitioner,

v.

FOCAL IP, LLC,  
Patent Owner.

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Case: IPR2016-01259 (Patent 8,155,298 B2)  
Case: IPR2016-01261 (Patent 8,457,113 B2)  
Case: IPR2016-01262 (Patent 7,764,777 B2) and  
Case: IPR2016-01263 (Patent 8,155,298 B2)<sup>1</sup>

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Before SALLY C. MEDLEY, JONI Y. CHANG, and  
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Authorization to File  
Supplemental Information  
*37 C.F.R. § 42.123*

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<sup>1</sup> This Order applies to each of the listed cases. We exercise our discretion to issue one Order to be docketed in each case. The parties, however, are not authorized to use this caption for any subsequent papers.

IPR2016-01259 (Patent 8,155,298 B2)  
IPR2016-01261 (Patent 8,457,113 B2)  
IPR2016-01262 (Patent 7,764,777 B2)  
IPR2016-01263 (Patent 8,155,298 B2)

On January 18, 2017, Petitioner contacted the Board (by e-mail, Ex. 3003) to request authorization to file rebuttal opinions by its declarant as supplemental information. Prior to institution, Petitioner submitted these declarations without authorization and we, therefore, expunged them. *See, e.g.*, IPR2016-01259, Paper 21.<sup>2</sup> Patent Owner opposes Petitioner's request. We agree with Patent Owner.

Submission of rebuttal testimonial evidence by Petitioner is premature at this juncture of the proceeding. We recently instituted trial in each of the instant cases and do not yet have Patent Owner's Response or Motion to Amend, if any, as these submissions are due in April. *See, e.g.*, IPR2016-01259, Paper 24.

In its request, Petitioner referenced our Order (*see, e.g.*, IPR2016-01259, Paper 21) on Petitioner's earlier unauthorized submission of its declarations. Petitioner now has the benefit of our analysis in our Decision to Institute in each case (*see, e.g.*, IPR2016-01259, Paper 23) as well as each of our Scheduling Orders setting forth, for example, times in each case for the Patent Owner's Response and the Petitioner's Reply, as well as our cautionary statement reminding Patent Owner that any arguments for patentability not raised in the response will be deemed waived (*See, e.g.*, IPR2016-01259, Paper 24, 3, 6).

Petitioner's request to submit rebuttal evidence does not take into account that "[a] reply may only respond to arguments raised in the corresponding opposition." *See* 37 C.F.R. § 42.23 (b). Furthermore,

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<sup>2</sup> Citations herein will be to IPR2016-01259, unless otherwise noted.

IPR2016-01259 (Patent 8,155,298 B2)  
IPR2016-01261 (Patent 8,457,113 B2)  
IPR2016-01262 (Patent 7,764,777 B2)  
IPR2016-01263 (Patent 8,155,298 B2)

Petitioner's proposal to submit just its evidence does not take into account our requirement that such evidence must be explained. *See* 37 C.F.R. §§ 42.22, 42.23 ("Oppositions and replies must comply with the content requirements of motions" and "[e]ach . . . motion . . . must include . . . [a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence.").

Based on the current record before us, we agree with Patent Owner that Petitioner's submission of rebuttal evidence at this juncture should not be authorized.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request (Ex. 3003) to submit rebuttal opinions by its declarant as supplemental information is *denied*.

PETITIONER:

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PATENT OWNER:

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